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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

JANVIER, JEAN D

ART UNIT

PAPER NUMBER

2162

DATE MAILED: 02/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/375,005

Applicant(s)

SUGAHARA, YASUO

Examiner

Jean D Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

***Response to Amendment***

The Examiner does not approve the new title because it is not descriptive. A preferred or suggested title is --INFORMATION DECISION APPARATUS SPECIFYING CUSTOMERS AND SUBSEQUENTLY DECIDING WHICH PROMOTIONAL MESSAGE IS APPROPRIATE FOR TARGETING THESE CUSTOMER--.

Furthermore, the Examiner approves the changes made to the specification in and hence a claim for foreign priority, previously denied, is now granted.

***Response to Arguments***

Applicant's arguments filed on November 30/01 (Paper no. 6) have been fully considered but they are not persuasive because of the following reasons-

First of all, Applicant argues that, in order to uphold a rejection under 35 U.S.C 102, the cited reference must teach each and every features of the claimed invention. The Examiner respectfully disagrees. In fact, if a feature or limitation is anticipated or inherent in the art, there is no need for the applied reference to disclose this particular feature or limitation of the claimed invention, as understood by the practitioners of the art.

Second of all, Applicant argues that the information decision apparatus, as recited in amended claim 1, processes information based on entered product specification specifying a promoting product, not on some predetermined criteria as taught by Deaton. This limitation is a

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mere simplification of targeting a customer based on his prior purchase history, as taught by Deaton. First, the process starts, as recited in claim 1 of the current Application, by entering information regarding the promoting product into a database and then finds a targeted customer upon analyzing the customer's prior transaction histories, which are stored in the database. These features are anticipated by Deaton who discloses a system wherein, for example, upon conducting a promotion for a new coffee brand, a particular user is targeted based on the user prior purchase history stored in the database, which determines after an analysis that the user is a heavy coffee drinker (col. 65: 20-24; col. 71: 30-45; col. 90: 36-50; col. 93: steps 267-272; col. 100: 64 to col. 101: 13; col. 101: 48 to col. 103: 45). Furthermore, Deaton's system can be used over a Wide Area Network, as shown in figure 19, wherein retailers can share customers' information in real-time so that customers can redeem discount coupons at a retail store different from the store that issued the coupons, contrary to the Applicant's findings.

Third, Applicant further argues that Deaton does not disclose the tendency matrix table used to decide the product information for each target customer or does not anticipate "a tendency matrix table that categorizes the transaction tendencies into at least two categories and indicates different product information by a combination of the transaction tendencies", as recited in claim 9. Once again, the Examiner respectfully disagrees with the Applicant's findings. Indeed, Deaton teaches a system wherein a customers' purchase history, such as price sensitive data, volume purchase data, frequency of shopping data, brand loyalty data and so on, is used not only to target the customers by offering different categories of discount coupons (coupon A, coupon M, standard coupon, echo coupon etc) redeemable on particular promotional products to

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the said customers, but also to anticipate or predict what the customers will purchase next and prepare a specific promotional package to target these particular customers (col. 71: 30-45 and steps 200-211; col. 100: 64 to col. 101: 13; col. 101: 48 to col. 103). Deaton, for example, clearly points out that transaction tendencies or patterns can be used to at least divide customers into two groups, that is customers who are price sensitive and those who are not. Based on this grouping, two different promotional messages regarding a particular promoted product will be generated. The customer who is price sensitive will receive a coupon with a higher value to encourage him to buy the promoted product while the other customer will receive a coupon with a lower value to buy the promoted product, as depicted in col. 93: step 272.

Finally, the current inventive concept has been previously disclosed by a plurality of computer retailers, especially Gateway that advertises if a customer buys a system now; he/she can exchange it later on for a new and faster system.

Since the Applicant's arguments as herein submitted are not persuasive and since the amendments to the claimed invention do not help overcome the prior art rejection, **the current office action as described below has been made final and the Applicant's request for allowance has been respectfully denied.**

## **DETAILED ACTION**

### ***Specification***

#### **Status of the claims**

Claims 1-21 were originally presented. After the First Non-final Office Action, claims 1-21 were amended and claims 22-27 were added. Claims 1-27 are now pending in the Instant Application.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-27 are rejected under 35 U.S.C. 102 (b) for being anticipated by Deaton et Al, U.S Patent 5,649,114, July 15, 1997.

As per claim 1, Deaton et al teach a system for providing selective incentives to a customer or “transactor” if and only if the customer’s or “transactor’s” shopping history or transaction history or purchase history meets some predetermined criteria, such as demographics,

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recency, frequency, volume purchase data, timing of purchases or purchase cycle data, brand loyalty, coupon redemption data and custom price sensitivity data and infrequent purchase data, as set forth by a retailer. Upon analyzing the shopping history data or purchase history data using a program subroutine as disclosed in figs. 18 and 23-47 or any conventional data mining technique, a decision is made, subsequent to determining the customer's purchase habits or pattern or tendencies, on whether or not the said customer should receive a selective incentive and/or be targeted for a particular product promotion. **See Col. 1: 66 to Col: 2: 4; Col. 65: 61 to Col. 67: steps 40-46; Col. 68: 8-16; Col: 71: 4 to Col.72: 58.** Subsequent to analyzing the customer's purchase habits or transaction tendencies, determining or predicting the customer's tendency to purchase a particular product and upon finding this product that the customer will soon buy or replace next on a given due date, providing a coupon to the customer redeemable on this particular product (col. 71: 31 to col. 72: 58).

See col. 65: 20-24; col. 90: 36-50; col. 93: steps 267-272; col. 100: 64 to col. 101: 13; col. 101: 48 to col. 103: 45.

As per claims 2 and 8, Deaton et al disclose a system for deciding on at least one customer's transaction habits or tendencies, **such as product loyalty or brand loyalty or product preference**, associated with at least one product type **such as coffee** listed in his/her purchase history data and subsequently providing to said customer an incentive or coupon, redeemable for a preferred product or a product used during a future transaction with a store (Col. 71: 31-45).

As per claims 3 and 7, Deaton et al disclose a system for detecting from a customer's transaction history a customer's transaction habits associated with a product type such as coffee (Col. 71: 31-45) and subsequent to detecting, providing an incentive or coupon to the said customer to buy a related or **new** product such as a coffee filter (Col.71: 46-67) and upon scanning a product at the POS in a future transaction with a store, determining that at least one of the products purchased is indeed the coffee filter and if so applying the discount and finally storing the redemption data in a BCTT table in a database associated with CVC Master Controller of fig.19 (fig. 22; Col. 77: step 1 to Col. 78: 10).

Claim 4 substantially recites the limitations of claim 2 and therefore, these limitations of claim 4 are rejected under a similar rationale. Claim 4 further recites **a product rank instead of a product type**. As per this feature, Deaton et al disclose a system for providing a selective incentive to a customer based on his transaction history. From the customer's transaction history data, transaction habits or tendencies, such as product preference, product heavily used (high ranking), product loyalty or brand loyalty or product infrequently used (low ranking) can be determined so that the customer can further be targeted (Col. 71: 31-67).

Claim 5 substantially recites the limitations of claim 3 and therefore, these limitations of claim 5 are rejected under a similar rationale. Claim 5 further recites **a product rank instead of a product type**. As per this feature, Deaton et al disclose a system for providing a selective incentive to a customer based on his transaction history. From the customer's transaction history data, transaction habits or tendencies, such as product preference, product heavily used (high



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ranking), product loyalty or brand loyalty or product infrequently used (low ranking) can be determined so that the customer can further be targeted (Col. 71: 31-67).

As per claim 6, Deaton et al disclose a system for deciding on at least one or more customer's transaction habits or tendencies, **such as product loyalty or brand loyalty, product preference or product frequency purchase**, associated with at least one product type **such as coffee** listed in his/her purchase history data and subsequently providing to said customer an incentive or coupon, redeemable for a preferred product or a product used during a future transaction with a store (Col. 71: 31-45). Deaton et al further disclose a system for providing a selective incentive to a customer based on his transaction history. From the customer's transaction history data, transaction habits or tendencies, such as product preference, product heavily used (high ranking), product loyalty or brand loyalty or product infrequently used (low ranking), can be determined so that the customer can further be targeted (Col. 71: 31-67).

As per claim 9, Deaton et al teach, among other things a system for targeting customers based on factors such as demographics, recency, frequency, volume purchase data, timing of purchases or purchase cycle data, brand loyalty, coupon, redemption data and custom price sensitivity. These factors are used to develop coupon lists, associated with customers' transaction habits or tendencies, which are spooled to a coupon printer for delivery to the customers at the checkout register. Alternatively, the coupon lists may be spooled to an electronic medium, such as customers' smart cards, or a store's system controller mass storage device for automatic electronic redemption on a future bill (figs. 19-45).

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Furthermore, Deaton et al teach a system for providing selective incentives to a customer or “transactor” if and only if the customer’s or “transactor’s” shopping history or transaction history or purchase history meets some predetermined criteria, such as demographics, recency, frequency, volume purchase data, timing of purchases or purchase cycle data, brand loyalty, coupon redemption data and custom price sensitivity data and infrequent purchase data, as set forth by a retailer. Upon analyzing the shopping history data or purchase history data using a program subroutine as disclosed in figs. 18 and 23-47 or any conventional data mining technique, a decision is made, subsequent to determining the customer’s purchase habits or pattern or tendencies, on whether or not the said customer should receive a selective incentive and/or be targeted for a particular product promotion. **See Col. 1: 66 to Col: 2: 4; Col. 65: 61 to Col. 67: steps 40-46; Col. 68: 8-16; Col: 71: 4 to Col.72: 58.**

Finally, Deaton teaches a system wherein a customers’ purchase history, such as price sensitive data, volume purchase data, frequency of shopping data, brand loyalty data and so on, is used not only to target the customers by offering different categories of discount coupons (coupon A, coupon M, standard coupon, echo coupon etc) redeemable on particular promotional products to the said customers, but also to anticipate or predict what the customers will purchase next and prepare a specific promotional package to target these particular customers (col. 71: 30-45 and steps 200-211; col. 100: 64 to col. 101: 13; col. 101: 48 to col. 103). Deaton, for example, clearly points out that transaction tendencies or patterns can be used to at least divide customers into two groups, that is customers who are price sensitive and those who are not. Based on this grouping, two different promotional messages regarding a particular promoted product will be generated. The customer who is price sensitive will receive a coupon with a higher value to

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encourage him to buy the promoted product while the other customer will receive a coupon with a lower value to buy the promoted product, as depicted in col. 93: step 272.

Claim 10 substantially recites the limitations of claim 1 and therefore, these limitations of claim 10 are rejected under a similar rationale.

Claim 11 substantially recites the limitations of claim 2 and therefore, these limitations of claim 11 are rejected under a similar rationale. Claim 11 further recites the limitations of claim 2 by merely replacing **a product type with a product rank**. As per this feature, Deaton et al disclose a system for providing a selective incentive to a customer based on his transaction history. From the customer's transaction history data, transaction habits or tendencies, such as product preference, product heavily used (high ranking), product loyalty or brand loyalty or product infrequently used (low ranking) can be determined so that the customer can further be targeted (Col. 71: 31-67).

Claim 12 substantially recites the limitations of claims 1 and 2 respectively and therefore, these limitations of claim 12 are rejected under a similar rationale as respectively applied in claims 1 and 2.

Claim 13 substantially recites the limitations of claim 7 and therefore, these limitations of claim 13 are rejected under a similar rationale.

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Claim 14 substantially recites the limitations of claim 8 and therefore, these limitations of claim 14 are rejected under a similar rationale.

Claim 15 substantially recites the limitations of claim 9 and therefore, these limitations of claim 15 are rejected under a similar rationale.

Claim 16 substantially recites the limitations of claim 1 and therefore, these limitations of claim 16 are rejected under a similar rationale. Claim 16 further recites a computer program product encoded on computer readable medium enabled, when executed on a computer or processor, to perform the steps of the claimed invention as disclosed herein. As per these features, Deaton et al disclose in figs.18 and 19-45 a computer program product or program subroutine encoded on a storage medium enabled, when executed on CVC Master Controller 965, to perform the tasks described above.

Claim 17 substantially recites the limitations of claim 11 and therefore, these limitations of claim 17 are rejected under a similar rationale. Claim 17 further recites a computer program product encoded on computer readable medium enabled, when executed on a computer or processor, to perform the steps of the claimed invention as disclosed herein. As per these features, Deaton et al disclose in figs.18 and 19-45 a computer program product or program subroutine encoded on a storage medium enabled, when executed on CVC Master Controller 965, to perform the tasks described above.

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Claim 18 substantially recites the limitations of claim 12 and therefore, these limitations of claim 18 are rejected under a similar rationale. Claim 18 further recites a computer program product encoded on computer readable medium enabled, when executed on a computer or processor, to perform the steps of the claimed invention as disclosed herein. As per these features, Deaton et al disclose in figs.18 and 19-45 a computer program product or program subroutine encoded on a storage medium enabled, when executed on CVC Master Controller 965, to perform the tasks described above.

Claim 19 substantially recites the limitations of claim 7 and therefore, these limitations of claim 19 are rejected under a similar rationale.

Claim 20 substantially recites the limitations of claim 8 and therefore, these limitations of claim 20 are rejected under a similar rationale.

Claim 21 substantially recites the limitations of claim 15 and therefore, these limitations of claim 21 are rejected under a similar rationale. Claim 21 further recites a computer program product encoded on computer readable medium enabled, when executed on a computer or processor, to perform the steps of the claimed invention as disclosed herein. As per these features, Deaton et al disclose in figs.18 and 19-45 a computer program product or program subroutine encoded on a storage medium enabled, when executed on CVC Master Controller 965, to perform the tasks described above.

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Claims 22, 24 and 26 substantially recite limitations already addressed in claim 1 and therefore, these limitations of claims 22, 24 and 26 are rejected under a similar rationale.

Claims 23, 25 and 27 substantially recite limitations already addressed in claim 9 and therefore, these limitations of claims 23, 25 and 27 are rejected under a similar rationale.

### **Conclusion**

Although the following references were not used in the Office Action, they were highly considered by the Examiner. Applicants are further directed to consult these references.

US Patent 6, 014,634- here, Scroggie et al disclose an incentive distribution method conducted over the Internet where a customer can download purchasing incentives redeemable at a retail store or place orders at a location remote the retail store.

US Patent 6, 026,370-This reference constitutes a relevant prior art under 102(e).

Japanese Patents- 06119309 A, 09237265 A and 06068065 A.

US Patent 5,974,396A to Anderson et al discloses a system for gathering and analyzing consumer purchasing information based on product and consumer clustering relationships.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at  
(703) 305-3900.

. Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-746-7238

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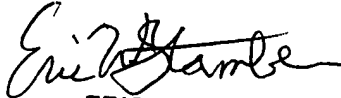
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Official Draft-703-746-7239

Non-Official Draft- 703-746-7240

**Please provide support, that is page and line numbers, for any amended or new claim, otherwise any new claim language that is introduced in an amended or new claim will be considered as new matter.**

JDJ  
11/6/01

  
ERIC W. STAMBER  
PRIMARY EXAMINER